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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,024	04/06/2005	Tetsuo Santo	JCLA14658	8756

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J C PATENTS, INC.  
4 VENTURE, SUITE 250  
IRVINE, CA 92618

EXAMINER
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CLARK, AMY LYNN

ART UNIT	PAPER NUMBER
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1655

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/511,024

Applicant(s)

SANTO ET AL.

Examiner

Amy L. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/08/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/8/2004;11/10/2005.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's arguments, see "Applicant Arguments/Remarks Made in an Amendment", filed 16 August 2006 and 13 October 2006, with respect to withdrawal of the species election requirement have been fully considered and are persuasive. The requirement for an election of species has been withdrawn.

Claims 1-9 are currently pending.

**Claims 1-9 are under examination.**

### ***Information Disclosure Statement***

The information disclosure statements (IDS) were submitted on 8 October 2004 and 10 November 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings are objected to because the images are unclear due to the fact that the photographs are dark and, therefore, it is difficult to see what Applicant is trying to illustrate via the photographs. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

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amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "when resistance power is poor and is known to be a disease accompanied by intense itch with wetting and erosion; the itch is characterized in that it gives a mental pain to the patients and aggravates symptoms by scratching" (See as an example, page 2, second paragraph). Please note that the entire specification is replete with errors, which begin on page 1 of the specification and

continue throughout the specification. The example provided by the Examiner is merely one example of the incomprehensive language found throughout the specification.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A tea for treating dermatitis comprising (list specific ingredients).

### ***Claim Objections***

Claims 1-5 and 7-9 are objected to because of the following informalities: Claim 1 should be corrected to read: "A ~~drinkable~~ tea for ~~therapy of~~ (treating?) dermatitis, ~~characterized in that it contains~~ wherein the tea comprises extracts (please see 112 2<sup>nd</sup> paragraph rejection below and insert appropriate language) ~~drawn~~ obtained from ~~Lightyellow light yellow~~ Ssophora Rroot (Latin name) and ~~lisatis L~~leaf (Latin name)." Please note that the Examiner has provided an example of how claims 2-5 and 7-9 should also be amended. Please amend claims 1-5 and 7-9 accordingly. Appropriate correction is required.

Claims 8 and 9 are objected to because of the following informalities: Claims 8 and 9 contains the abbreviation, "g", (See line 3 in claim 8 and in claim 9 (line 1 on the

final page of the claims, wherein claim 9 is continued) which is not defined in the claims.

Appropriate correction is required.

Claim 9 is objected to because of the following informalities: licorice is misspelled in line 4 of the final page of claims, wherein claim 9 is continued.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claim 1-5 and 7-9 are rendered uncertain by the phrase "A drinkable tea for therapy of dermatitis characterized in that it contains extracts drawn from Lightyellow Sophora Root and Isatis Leaf" for the following reasons. First of all, "drinkable tea" is redundant. Tea, by definition, is drinkable. Secondly, what is "therapy of dermatitis"? Does Applicant mean that it is used in treating dermatitis? Finally, what does "extract" mean? Is Applicant claiming an aqueous/organic extract or a particular compound obtained from each plant or a compound extracted that is common to both plants? Please note that these rejections apply to the vague terms, "extract" and "drinkable" found in the other claims. Please amend these claims

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accordingly. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

The metes and bounds of Claims 1-4 and 7-9 are uncertain because it is unclear as to the identification of the ingredients to which Applicant intends to direct the subject matter. Although the use of common names or traditional/ethnopharmacological names is permissible in patent applications, the standard Latin genus-species name of each ingredient should accompany non-technical nomenclature as a means for identifying the subject botanical as noted in this application. The common name or traditional/ethnopharmacological name may have several different Latin names referring to various genus-species of the plant and it is unclear as to which genus and species Applicant is referring. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired. Applicant may overcome the rejection by placing the genus-species name of "Lightyellow Sophora root", "Isatis Leaf", "Terminalia Fruit", "Japanese Angelica Root", "Dried Tangerine Peel", "Wild Chrysanthemum Flower", "Corydalis", "Peppermint", "Baikal Skullcap", "Lithospermum", "Kudingcha", "Smartweed" and "Licorice" in parentheses after the terms "Lightyellow Sophora root", "Isatis Leaf", "Terminalia Fruit", "Japanese Angelica Root", "Dried Tangerine Peel", "Wild Chrysanthemum Flower", "Corydalis", "Peppermint", "Baikal Skullcap", "Lithospermum", "Kudingcha", "Smartweed" and "Licorice".

The metes and bounds of Claims 4, 5, 8 and 9 are rendered uncertain by the phrase "The drinkable tea for therapy of dermatitis described in claim 1 characterized in

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that said extracts drawn from Lightyellow Sophom Root and Isatis Leaf and the weight ratios of extracts drawn from lightyellow Sophora Root, and Isatis Leaf are 41 to 50% of Lightyellow Sophora Root, and 41 to 50% of Isatis Leaf” in claim 4 because it is unclear if the ratio of the ingredients are in relation to each other or the entire composition, the phrase “The drinkable tea for therapy of dermatitis described in claim 4 characterized in that the weight ratio of said extracts drawn from Lightyellow Sophora Root, Isatis Leaf, and the auxiliary material in said drinkable tea is 18 to 25% : 75 to 82%” in claim 5, the phrase “The drinkable tea for therapy of dermatitis described in claim 7 characterized in that the weights of extract ingredients drawn from respective medicinal herbs per g of a drinkable tea are: Lightyellow Sophora Root, 0.09 to 0.11 g; and Isatis Leaf, 0.09 to 0.11 g; and the weights of said auxiliary material are: Japanese Angelica Root, 0.045 to 0.055 g; Oldenlandia diffusa, 0.09 to 0.11 g; Smilax Glabra, 0.108 to 0.132 g; Dried Tangerine Peel, 0.045 to 0.055 g; Wild Chrysanthemum Flower, 0.09 to 0.11 g; Corydalis, 0.018 to 0.022 g; Peppermint, 0.09 to 0.11 g; Baikal Skullcap, 0.045 to 0.055 g; Lithospermum, 0.09 to 0.11 g, Kudingcha, 0.045 to 0.055 g; Smartweed, 0.09 to 0.11 g; and Licorice, 0.0273 to 0.033 g” in claim 8 and “The drinkable tea for therapy of dermatitis described in claim 8 characterized in that the weights of extract ingredients drawn from respective medicinal herbs per g of a drinkable tea are: Lightyellow Sophom Root, 0.1 g; and Isatis Leaf, 0.1 g; and the weights of said auxiliary material are: Japanese Angelica Root, 0.05 g; Oldenlandia diffusa, 0.1 g; Smilax Glabra, 0.12 g; Dried Tangerine Peel, 0.05 g; Wild Chrysanthemum Flower, 0.1 g; Corydalis, 0.02 g; Peppermint, 0.01 g; Baikal Skullcap, 0.05 g; Lithospermum, 0.1 g; Kudingcha, 0.05 g;



Smartweed, 0.1 g; and Lucorice, 0.03 g." in claim 9 because the amounts of the ingredients are not set forth in terms of either "by weight" or "by volume" amount of the total composition. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ho et al. (A, US Patent Number: 5,466,443).

Ho teaches an herbal-based composition comprising prepared *Radix Sophorae Flavescentis* (which is synonymous with Lightyellow Sophora Root), *Indigo naturalis* (which is synonymous with Isatis leaf) and *Radix Angelica Sinensis* (which is synonymous with Japanese Angelica Root), which reads on extract drawn from Lightyellow Sophora Root, Isatis leaf and Japanese Angelica Root. Ho further teaches the herbal-based composition comprises dried *Radix Sophorae Flavescentis*, *Indigo naturalis* and *Radix Angelica Sinensis*, which is ground into a powder and then boiled in water (See Abstract, column 3, "Table 1", column 4, lines 15-67, continued into column 5, lines 1-18), which reads on drinkable tea in powder form.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Therefore, the reference anticipates the claimed subject matter.

\* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amy L. Clark  
AU 1655

Amy L. Clark  
March 31, 2007

  
MICHELE FLOOD  
PRIMARY EXAMINER